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Serial No. 10/054,257

Pre-Appel Brief Request for Review

UTILITY PATENT

B&D No. TN -2239

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Frederick R. BEAN et al.**

Serial No.: **10/054,257**

Examiner: **P. Nguyen**

Filed: **January 22, 2002**

Group Art Unit: **3724**

For: **MITER SAW**

Assistant Commissioner for Patents
Washington, DC 20231

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 10-25-06 *[Signature]*

Dear Sir:

This is in response to the final Office Action of August 4, 2006. A Notice of Appeal has been filed herewith.

Applicants request that the rejections and the restriction requirement in the present case be withdrawn.

The Examiner rejected Claim 13 under 35 USC § 102(b) as being anticipated by US Patent No. 5,957,021 ("Meredith"). In addition, the Examiner rejected Claims 13-14 and 16 under 35 USC § 103(a) as being unpatentable over Meredith in view of US Patent No. 4,870,758 ("Fushiya"). These rejections are respectfully traversed.

Admittedly, Meredith discloses a chop saw with a base assembly, a saw assembly with an upper blade guard, a plate rotatably attached to the upper blade guard, a lower blade guard

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rotatably attached to the plate, and a screw engaging the upper blade guard for fixing the plate, where the plate has a first tab disposed near the screw and extending outwardly and substantially perpendicularly to the plate, the first tab extending from the at least one of the upper blade guard and plate a first distance, the screw being required to be moved a second distance longer than the first distance in order to pivot the plate.

However, Meredith is silent as whether the lower blade guard can contact the screw upon rotation of the lower blade guard once the screw is moved to clear the first tab. This is not surprising, as FIGS. 10d-11 of Meredith show the final position of lower blade guard 42 blade guard when fully pivoted. As shown in such figures, lower blade guard 42 cannot contact screw 69 regardless of the screw's position.

By contradistinction, Claim 13 requires "that the lower blade guard contacts the screw upon rotation of the lower blade guard, wherein the lower blade guard contacts the screw upon rotation of the lower blade guard after the screw has been moved the second distance." Being that such result is impossible with the Meredith guard, Meredith cannot anticipate or render unpatentable Claim 13 and its dependent claims.

Such missing element is not shown either in Fushiya as Fushiya does not disclose any screws contacting lower blade guard 21. Accordingly, the Meredith/Fushiya combination cannot render unpatentable Claim 13 and its dependent claims. Therefore, the rejections based on Meredith and Meredith/Fushiya should be withdrawn.

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The Examiner also rejected Claims 13 and 15 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,778,747 (“Chen”) in view of Meredith. This rejection is respectfully traversed.

As admitted by the Examiner, Chen does not disclose the claimed first tab. The Examiner relies on Meredith to provide such first tab. As discussed above, Claim 13 requires more than just a first tab.

Claim 13 also requires that the lower blade guard can contact the screw upon rotation of the lower blade guard once the screw is moved to clear the first tab. As shown in FIG. 11 of Meredith, lower blade guard 42 cannot contact screw 69 regardless of the screw’s position. Chen is necessarily silent on such feature as it does not have the first tab.

By contradistinction, Claim 13 requires “that the lower blade guard contacts the screw upon rotation of the lower blade guard, wherein the lower blade guard contacts the screw upon rotation of the lower blade guard after the screw has been moved the second distance.” Being that such result is not taught or suggested by Chen and/or Meredith, the Chen/Meredith combination render unpatentable Claim 13 and its dependent claim. Therefore, the rejections based on Chen/Meredith should be withdrawn.

Finally, Applicants would like the Examiner to reconsider his improper restriction requirement. The Examiner has argued that prior to the amendment of February 21, 2006 the three groups overlapped. This apparently changed when the Applicant amended Claim 13 on

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February 21, 2006.¹ According to the Examiner, such amendment “creates a serious burden on the Examiner” because the Examiner has to search many additional classes.

This is not so. Independent Claim 9 has been fully searched. No new search is necessary because Claim 9 was not amended. Similarly, independent Claim 1 has been fully searched. No new search is necessary because Claim 9 was not substantially amended. Thus the searches for the first two groups have been already conducted and no new searches are necessary. The only search that is necessary would be for independent Claim 13, which is the elected claim.

Accordingly, no additional searches should be necessary.

Finally, examining all three groups together would satisfy MPEP § 811. According to such section, “the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.” In the present case, the Examiner should continue examining all three groups rather than issue a restriction requirement after four years of pendency and over two years of active examination on all three groups.

Accordingly, Applicants request that the Examiner continue examination of Groups I and II, as no additional burden would be imposed.

¹ Applicants submits that, since independent Claim 1 (which was directed to the miter saw’s wear ring) was only amended by adding 2 words and independent Claim 9 (which was directed to the

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In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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miter saw's sliding fence) was not amended at all, the only substantial amendment was to independent Claim 13.